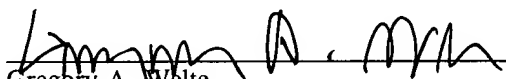IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Assignee's Docket No.:   8594.00   )
)
Group Art Unit: 2178   )
)
Serial No.:   09/829,225   )
)
Examiner: Cesar B. Paula   )
)
Filing Date: April 9, 2001   )
)
Title: Improved Operation of   )
          Web Sites on Internet   )
)
_____   )

REPLY BRIEF

OVERVIEW OF REPLY TO REJECTION OF CLAIM 1

Example of Claimed Subject Matter

A person visits a web site on the Internet. The web site identifies the person in some manner, as by name, profession, hobbies practiced, etc. (The actual name of the person is not necessarily important, because the purpose of the identification is to provide a basis for selecting advertising which is presented to the person.)

Once the person is identified, background research is undertaken, to identify characteristics which would indicate buying

habits of the person. For example, it may be found that the person

is a professional golfer. That fact would affect the type of

advertising chosen.

Based on the background research, advertising is selected,

which is transmitted to the computer being used by the person.

Claim 1

Consistent with this example, claim 1 states:

> 1.   A method of operating a web site,
> comprising:
>
> a)   identifying a first visitor to the web site;
>
> b)   performing first background research on
> the first visitor;
>
> c)   based on the background research,
> selecting first information from a collection
> of information; and
>
> d)   transmitting the first information to the
> first visitor.

The "first information" can be the advertising discussed

above.

Examiner's Answer

The Answer appears to present a new ground of rejection, in

reading claim 1 onto **two different transactions** in the Javascript

reference.

The Answer asserts that, when a person first visits a web site, that person gives his name. Software on his computer stores the name in a cookie. The Answer asserts that this shows claim 1(a).

Then, **later,** when the person visits the web site again, software on his computer

      1)   finds the cookie,

      2)   locates the name in the cookie, and

      3)   displays the name on the screen, as in

      "Hello, John Q., welcome back."

The Answer asserts that

      A)   item (1), above, finding the cookie, shows

      claim 1(b), performing background research;

      B)   item (2), locating the name within the

      cookie, shows claim 1(c), selecting the first

      information from a collection; and

      C)   item (3), displaying the name, shows claim

      1(d), transmitting the first information to

      the person. (See Table, page 12.)

This application of claim 1 to Javascript is fraught with error, as will now be outlined.

One Error

The claim clearly refers to a single transaction, wherein the

claim elements are connected with each other.

The Answer reads claim 1(a) onto an event which is completely unrelated to claims 1(b), (c), and (e).

Stated another way, claim 1 is classified under the patent law as a "process" or "method." It recites a **single process**.

It cannot be read onto two different processes.

Second Error

In the reference, when the person visits the web site the second time, the software locates the cookie corresponding to the web site.

That cannot be considered "background research" on the person, for several reasons.

Reason 1

"Background research" refers to ascertaining facts about the person's life. A person's name is not ordinarily considered "background."

Reason 2

When the supposed "background research" is being done, the person's name is not known. At that time, the person is just another anonymous visitor to a web site.

You cannot perform "background research" without knowing the

name of the person being researched.   (As explained later, the purpose of the "background research" in Javascript is actually to identify the person, not obtain "background.")

Reason 3

The Answer states that this "background research" involves searching for the person's name.   (See Table, page 12, row 2.)

That is not actually correct.

The name (if present) is stored in a cookie.   The cookies are stored as files, each bearing the name of the web site owning the cookie.

But the name of the person is not searched directly.   The name of the web site is searched for, to find the web site's cookie.

So the "research" is actually being done to locate a cookie owned by the web site.   If a name is contained in the cookie, it is retrieved.   That process cannot be called "background research" on the visitor to the web site.

Reason 4

In actual fact, the purpose of this activity in Javascript is to learn the name of the person.

The purpose is to identify the person.

This means that, under the Answer's application of Javascript, **the person is identified TWICE.**

-- Once in the initial visit to the web site,

where the person gave his name (which is used

to show claim 1(a).)

-- Now, in the second visit, in the cookie-

look-up (which is used to show claim 1(b)).

That simply makes no sense. The Answer reads claim 1 onto two

processes of identification, when the claim recites one

identification step.

The PTO tries to overcome this problem by the subterfuge of

calling the second identification "background research."

That exalts form over substance.

Third Error

Claim 1(c) recites:

> c)   based on the background research,
> selecting first information from a collection
> of information.

The answer asserts that, in Javascript, the retrieval of the

name from the cookie shows the claimed "selecting." However,

several problems exist here.

Problem 1

The claim clearly implies, since the Specification explicitly

so states, that the "first information" could be selected from the

"collection of information," and is not limited to the name, as in the case of the cookie.

That is, for example, under the claim, the "collection" may contain advertising relating to all types of golf equipment. But only certain information is "selected."

Nothing analogous occurs in Javascript. The name in the cookie is assigned to a specific data field. The software is programmed to retrieve that name, and nothing else, as the "name" of the person.

There is no "selecting" as recited in claim 1. Nothing in the supposed "collection" in Javascript can be retrieved as the name. Only the name can be retrieved. There is no choice.

The mere fact that the cookie in Javascript contains other information besides the name does not mean that the name is "selected from a collection of information." In English, that phrase implies that something else could be "selected" from the "collection."

In Javascript, the name is not "selected." It may be "retrieved," but it is not "selected."

Problem 2

POINT 1

The claim states that the "selecting" is done **based on** the background research."

How can the supposed "selecting" in Javascript, which involves no choice at all, but only retrieving a name from a specified location, be "based on" the "background research" ? (Table, page 12, row 2.)

Appellant submits that the answer is: Javascript simply does not show the claim language.

POINT 2

The Answer is asserting that the process of searching for the cookie containing the name amounts to "background research." However, as explained above, that "research" is actually an attempt by Javascript to identify the person, since the identity of the person is not known at the time.

When the cookie of the web site is found, software retrieves the name, if present, within the cookie. No "selecting" occurs. "Retrieval" occurs.

And that "retrieval" cannot be said to be "based on the background research," because that makes no sense.

The retrieval is a mechanical operation, and is done irrespective of any facts uncovered in any "background research."

POINT 3

The Answer finds claim 1(b) in the supposed search for the user's name in Javascript. (Table, page 12, row 2.)

The Answer finds claim 1(c) in the "selecting" of the name from the cookie, once found. (Table, page 12, row 3.)

This is double-counting, and is not allowed.

The Answer is counting a **single operation** in Javascript as showing **two claim recitations**.

The **single operation** is retrieving a name from a cookie-file bearing the name of the web site.

The Answer's breaking of the **single operation** into two operations is clearly a fabrication, which is proven by the simple fact, that, at the time of the retrieval of the cookie, the identity of the user is not known. Therefore, the **single operation**, or a part of it, cannot qualify as "background research."

You cannot perform "background research" on an unknown person.

Another fact is that, if it is reasonable to treat the **single operation** as two separate operations, then those operations should exist separately.

> -- How can the retrieval of the name from the cookie in Javascript occur without locating the cookie, that is, without performing the supposed "background research" ?

POINT 4

Claim 1(c) is repeated:

> c)   based   on   the   background   research,
> selecting first information from a collection
> of information.

The Answer, in effect, re-writes claim 1(c) as follows:

> c)   based   on   locating   the   cookie,   selecting
> the name from the cookie.

That   is,   the   Answer   asserts   that   selecting   (actually
retrieving) the name from the cookie is "based on" finding (or
searching for) the cookie.

That makes no sense.

The   claimed   subject   matter   is   completely   different.   The
selection   selects   advertising   (for   example)   "based   on"
characteristics of the person found in the "background research."
That does make sense.

Fourth Error

Claim 1 recites processes, all of which are "comprised" of "a
method of operating a web site."

None, or very little, of the operations in Javascript occur
in a web site.   Everything is done by software on a user's
computer, which requests web pages from a web site.

The wrong agency is performing the actions in Javascript.

Fifth Error

Claim 1(d) recites "transmitting the first information to the first visitor." But the "first information" (the visitor's name, according to the Answer) is already present on the computer of the first visitor.

Sixth Error

As just stated, the "first information" is transmitted to "the first visitor."

But, under the Answer's view, the "first visitor" is the party in a previous transaction who gave a name, which was stored in a cookie.

The present visitor is not the "first visitor." It is possible that the present visitor is the same person, but it is a different visitor.

Comment 1

The Answer is bending and twisting the meaning of the claim terms beyond their reasonable limits.

-- The claim clearly refers to a **single** transaction.

-- The claim does not recite a duplicate identification step. But, as explained above, the Answer finds a duplicate identification,

but re-names one as "background research."

--   The Answer does not explain how "background research" can be done without identifying the subject of the research. Thus, no "background research" is actually present in Javascript.

--   The Answer does not explain why a process in Javascript can justifiably be called "background research," when that process retrieves a name of a person, and the process is designed to identify the person.

--   And, as the "sixth error" above indicates, stretching the claim to cover two transactions creates a problem as to who is the "first visitor."

Appellant submits that, if literal anticipation is present, then this is a case of "accidental anticipation."

"Accidental anticipations" are those which occur only under unusual circumstances, and do not constitute anticipations under section 102.   (See Law of Patents, by D. Chisum, §§ 3.03 and 3.03(2).)

Comment 2

Appellant submits that the rejection is actually obviousness-

type, and not anticipation.

If a single reference shows multiple different embodiments, and if a rejection combined component A in embodiment A with component B in embodiment B, that is an obviousness rejection. Because the **combination of AB is not found,** only A and B separately.

Similarly, in this case, the rejection combines steps taken from **two different processes,** in order to reject a single method claim. Appellant submits that this is actually an obviousness rejection, which does not comply with the rules under section 103.

Not all comments in this Overview are elaborated below.

END OVERVIEW

Response to Answer, up to Page 12

This part of the Answer repeats previous rejections, which are addressed by the Brief.

Response to Answer, Page 11, Last Paragraph, and Table on Page 12

Point 1

This section of the Answer is rebutted by the Brief, "Summary of Major Points of Argument," relating to claim 1, which spans pages 12 - 20.

Point 2

It appears that the Answer contains a new ground of rejection, namely, that the processes of claim 1 are now found in **two separate transactions**. That is, according to the Table on page 12 of the Answer, claim 1(a) is found in a first visit to a web site, and claim 1(b) is found in a **later** visit.

But the person in the **later** visit is not the claimed "first visitor." That person is **another** visitor, and it is not known whether that person is the second, fifth, hundredth, etc.

Further, claim 1(d) recites "transmitting the first information to the first visitor." According to the Table, the information is transmitted to the **later visitor** (the "first visitor" is now gone). That does not show the claim.

From another point of view, the Answer is reading claim 1 onto a collection of unrelated events in the prior art. Claim 1 plainly recites a **single transaction**. It is a method claim. It cannot be read onto two methods.

Appellant offers to amend claim 1 in this regard, if the Board so directs, but that is seen as unnecessary.

Point 3

Appellant submits that a fatal flaw exists in the Table.

The Answer apparently assumes that, in Javascript, a person's name is requested once, and stored in a cookie. The Answer assumes

that this name is retrieved whenever the same computer is later used.

However, Appellant submits that another type of operation is equally plausible. For example, when the undersigned attorney visits Amazon.com, a banner is displayed which states something like "Hello, Greg Welte. If you are not Greg Welte, click here." Presumably, the name "Greg Welte" was obtained from a cookie.

If you "click" as prompted, you are requested to enter your name.

It is reasonable to assume that, if Javascript wished to accurately identify visitors, then Javascript would do the same thing. In that case, no cookie-look-up would occur. The events of Table 1 are not present, and claim 1 would not be shown.

Appellant thus submits that Javascript does not necessarily operate as the PTO infers.

Point 4

As the Brief explains, the name which the user gives, in row 1 of the Table, is not transmitted to the web site. That name is merely stored in a cookie.

The claim language states that a "web site" performs the identification. The steps in Javascript which perform the supposed identification do not occur at a web site.

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Point 5

The Table is technically incorrect. To show claim 1(b), the Table asserts that a "search of the user's name" is done. That is not actually so.

The Table is referring to the look-up of a cookie. As the Brief explained, that is not done based on the "user's name." It is done based on the name of the web site, under which the cookie is stored. The reader can verify this on the reader's own Windows computer, by looking up the stored cookies.

Point 6

The Table is further incorrect as to claim 1(b). The Answer asserts that the cookie-look-up qualifies as performing "background research" on the "first visitor."

But the "first visitor" is not present at this time. He is gone.

Further, the Answer appears to make a fundamental error in the assessment of how web sites operate. The web sites are not omniscient. Even if the Answer's "first visitor" returns to a web site, after previously giving his name as in the first row of the Table, the web site has no idea who the visitor is, upon arrival.

To repeat: even assuming that

> 1)   the first visitor previously gave the
>
>   correct name and

2) that same visitor makes a later visit

nevertheless, when that visitor arrives at the later visit, the web site does not know the identity of that later visitor.

How can the web site perform "background research" on **the first visitor** at that time, when the web site lacks the identity of that later visitor ?

Restated, to perform "background research" on "the first visitor," you must know the **identity** of the "first visitor." If you do not know the identity, you cannot perform the "background research."

The Table, row 2, is asserting that the cookie-look-up qualifies as the "background research" when, in fact, it is an attempt to identify an unknown visitor.

So this is the fundamental error: the Answer is apparently **assuming** that the web site knows that a later, unknown, visitor is actually the previous "first visitor." Then the Answer asserts that the cookie-look-up, which may provide the person's name, qualifies as "background research."

But it only could be "background research" if the web site presumes to know the identity of the non-identified person.

The person is not identified until the cookie is found. And then, he still may remain unidentified.

**Response to Answer,
Page 12, Second-to-Last Paragraph**

Appellant asserted that the cookie-look-up does not amount to identification, because the cookie-look-up does one thing. It reports the name previously given by a **previous user** of a **given computer**. That name is stored in the cookie.

The PTO has not shown why that name, even if it is the correct name of the previous user, must be the name of a later user of that same computer, who visits the web site in question. It may be.

For example, assume a husband visits the web site and gives his name. If his wife then uses the same computer to visit the web site, how is she identified ? The cookie will indicate that the husband is visiting.

Further, the Answer's "identification" does not occur in a the same transaction as used to show the rest of claim 1. Claim 1 clearly recites a single transaction.

**Response to Answer,
Page 12, Last Paragraph - Page 13, First Full Paragraph**

As to the assertion that "computers have the capability of artificial intelligence . . .", Appellant points out that this is not relevant.

It may be true that **some** computer can accurately identify a person. But such a computer has not been shown in the prior art.

Appellant's analogies are given to show that the mere transfer

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of data does not amount to "identification."

Response to Answer,
Page 13, Second Full Paragraph

Again, the Office Action is relying on multiple transactions to show the claim elements of a single claim. The claim clearly recites a single transaction, a single method.

Response to Answer,
Page 13, Third Full Paragraph

The user who identified himself in a previous transaction is not the "first visitor" as in claim 1(d).

The Answer states that the claim does not specify **who** performs the identification. That is incorrect.

Claim 1 states:

> 1. A method of operating a web site, comprising:
>
> a) identifying a first visitor to the web site;
> . . .

The "identifying" step is "comprised" in the "method of operating a web site." The party "operating the web site" identifies the "first visitor."

That is not found in row of the Answer's Table, because the web site never learns that name.

**Response to Answer,
Page 13, Paragraph Beginning at Bottom**

<u>Point 1</u>

This paragraph is completely mis-directed.

Appellant's Brief stated:

> **No "Identifying" Actually Found in Javascript
> - Part II**
>
> As explained in the section following the next
> section, the content of the cookies in
> Javascript **is not transmitted to any web site.**
>
> Thus, the web site being visited by a visitor
> never obtains the name in the cookie.
>
> Consequently, the web site does not, and
> cannot, "identify" the visitor, as in claim
> 1(a).
>
> (Second Corrected Appeal Brief, mailed
> December 26, 2006, page 24.)

The Brief explains a fact of the Javascript reference, namely,

that the web site does not obtain the content of the cookies.

Thus, the web site does not obtain the names in the cookies.

Consequently, the web site cannot identify visitors (or

perform "background research" etc.) using the cookies.

It is irrelevant whether the claims contain the content of the

material immediately above, in this section.

That material presents **facts** which indicate that the web site

in Javascript cannot perform the operations claimed.

Appellant is not required to **claim** those **facts**, as the Answer asserts.

Point 2

This paragraph, on page 14, states that claim 1 does not recite transmission of any information from the web site to the client. That is incorrect.

As an example, the actions recited in claim 1 are performed by the web site, or the party operating the web site. Claim 1(d) states "transmitting the first information to the first visitor." For that claim recitation to be shown, the "transmitting" must be done in "a method of operating a web site" which method "comprises" the "transmitting."

Point 3

This paragraph, at the end, in essence states that, to show the claim, the actions of claim 1 can be shown performed by anybody.

That is not so. Claim 1 recites "identifying," "performing," "selecting," and "transmitting" steps. If those steps are found in the prior art, then to show claim 1, those steps must be found in "a method of operating a web site" which method "comprises" those steps.

Response to Answer,
Page 14, First Full Paragraph

Point 1

This paragraph states that Javascript teaches "sending back cookie data."

Claim 1 does not recite that. It recites "d) transmitting the first information to the first visitor."

Thus, the paragraph's statement is not relevant, and does not show the claim.

Point 2

As the Brief explains, the "sending back" is actually a retrieval of data from the user's computer, and displaying the data to the user. That does not show the recitations of claim 1.

Response to Answer,
Page 14, Second Full Paragraph

This paragraph is addressed elsewhere.

Response to Answer,
Page 14, Third Full Paragraph

This paragraph is addressed elsewhere.

Response to Answer,
Paragraph Beginning at Bottom of Page 14

The Answer asserts that Javascript remembers the names of all

users who visit a web site. But that only occurs if each user operates a different computer, and if no other persons utilize those computers.

If the users operate the **same computer**, as in a family, then a single cookie is present. The cookie-look-up will return the same cookie, no matter which family member uses the family-computer.

Therefore, Appellant's point is that accuracy in identification of the user in Javascript is accidental.

Further, as explained elsewhere, the identification in Javascript is not sent to the web site. So the operations utilizing the identification are not performed by the web site, as claimed.

Response to Answer, Page 15, First Full Paragraph

Again, the Answer is presuming omniscient operation in Javascript, which does not occur.

When Javascript looks up the cookie, it searches for the cookie named after a web site. At this time, the visitor is unknown.

When it finds the properly named cookie, it extracts a name, if present, from the name field. That name may, or may not, correspond to the visitor.

That is not "background research" on the visitor.

The identity of the visitor was not known when the "research" is performed.

The Javascript process should be accurately described. It

-- locates the name of a web site's cookie,

-- retrieves a person's name, if present,

from the cookie, and

-- displays that name.

That name is merely a name entered by a user of that same computer during a previous visit. Finding that name cannot be called "background research" on a current visitor.

Response to Answer,
Page 15, Second Full Paragraph

The "research" is not done on John Q. The cookies are named after the web sites. A web site searches for a cookie bearing its name.

Appellant respectfully submits that the Answer's assertions in this paragraph make no sense at all. The Answer asserts that the "research is done on John Q" (ie, on the visitor).

However, when the visitor arrives, his identity is not known. How does the web site know that John Q has arrived ?

Under the PTO's interpretation of Javascript, the web site learns from the cookie. But if a cookie named "John Q" is present, how does Javascript know to look for that one, as opposed to "Greg

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W" ?

Javascript searches for the cookie named after the web site. When that is found, a name may be in the cookie. That name may be the visitor's name.

Further, as explained herein, the name is not transmitted to the web site.

Response to Answer,
Last Paragraph of Page 15

Again, the Answer is presuming omniscient operation of a web site.

When the visitor arrives at a web site, his identity is unknown. A cookie bearing the name of the web site is sought. The visitor's identity is still unknown.

When the cookie is found, a name may be present in the cookie. That name, if present, may be the visitor's name.

But that cannot be "background research" on the visitor. That is an attempt to identify the visitor, so that the "background research" can then be done.

You cannot perform "background research" on an unknown person.

Response to Answer,
Page 16, First Full Paragraph

Assume a family of members A, B, C, D, and E. They all use the same computer. They all visit a certain web site.

Assume that they all give the web site their names, in separate visits.

When member C later visits that web site, how does the web site known that C is the visitor ?

Javascript does not explain how that is done.

Appellant submits that it is not done. The web site has a **single** cookie in the family's computer. That cookie cannot tell anybody, during any given visit, who is visiting.

The Javascript passage cited by the Answer is only relevant to separate users, who use separate computers, wherein nobody else uses the separate computers. Restated: the single cookie in each computer names the sole user of that computer.

But that does not always occur. Therefore, Javascript does not accurately identify the visitor.

Response to Answer, Page 16, Second Full Paragraph

To show the claim, "A method of operating a web site" must perform the "background research."

In Javascript, the supposed "background research" is a cookie-look-up, which may, or may not, produce a person's name. That name may, or may not, be the visitor's name.

But that process has not been shown in "a method of operating a web site."

Response to Answer,
Page 16, Third Full Paragraph

No response needed.

Response to Answer,
Last Paragraph of Page 16

The Answer, Table 1, page 12, states that the "first information" is "selected" from the cookie.

The web site does not perform that "selecting."

The web site does not "transmit" the "first information" to the "first visitor."

Javascript does both.

The claimed operations must be done by a "method of operating a web site."

Response to Answer,
Page 17, First Full Paragraph

The Brief, section entitled "Claim 6," beginning on page 42, sub-section "Point 2" addresses this paragraph.

Response to Answer,
Page 17, Third Full Paragraph

No response needed.

Response to Answer,
Page 17, Fourth Full Paragraph

The section of the Brief referenced by this paragraph
addresses the issues.

Response to Answer,
Last Paragraph of Page 17

Claim 10(e) recites:

> e) compiling the visitor-specific
> information and the response information into
> a message, and transmitting the message to the
> visitor.

The Answer is saying that a "message" is found in the prior
art, which is **formatted according to the "visitor specific
information."**

Such a "message" does not correspond to the claimed message.
The claim states that the "visitor-specific information" is
contained in the message.

Formatting the message to be consistent with such information,
which the PTO relies on, is different.

"Visitor-specific information" is "information" about the
"visitor," such as his preferences.

Transmitting a message to the visitor, which is presented in
a manner which complies with the visitor's preferences, which the
PTo relies on, is not transmitting "visitor-specific information"
to the visitor, as claimed.

The PTO's message itself, because it is consistent with the

"preferences," does not become "visitor-specific information."

The claim states that this "information" is in the message, not that the message's appearance is consistent with preference-information.

Response to Answer,
Page 17, Second Full Paragraph from Bottom

The Brief, page 47, "Point 4" addresses this paragraph.

Response to Answer,
Page 17, Last Paragraph

The Brief, pages 48, 49 address this paragraph.

Response to Answer,
Page 19, First Full Paragraph

The Brief, page 50, addresses this paragraph.

The Answer's attempt to resolve the contradiction, in essence,

    1) re-states the contradiction and then

    2) states, without evidence, that no contradiction exists.

Further, in attempting the resolution, the Answer states that the "web page" which is "sent back" contains the "name." As explained elsewhere, the web site never obtains the name from the cookie. Thus, the "name" cannot be "sent back."

Response to Answer,
Page 20, First Paragraph

The discussion in the immediately preceding section applies here, with the exception of the reference to the Brief, which here should be to page 51.

Response to Answer,
Page 20, Second Paragraph

Appellant now sees that claim 13(d) is asserted to be present in Nehab. It is referred to in the italicized part of the first full paragraph of page 9 of the Office Action, but without being identified as "d."

Nevertheless, 13(d) is not found in Nehab, as the Brief, beginning on page 51, explains.

Response to Answer,
Page 20, Last Paragraph

The steps of the claim are "comprised" in "a method of operating a web site." That has not been shown in Nehab, as the Brief explains.

Response to Answer,
Page 21, First Full Paragraph

The Answer asserts that "Nehab teaches that a web page is built based on what the website thinks," and cites column 8, lines 38 - 67.

However, that passage indicates that the web site merely follows the instructions of the user, as in looking for key words specified by the user.

No "estimate" by the web site, as claimed, is seen.

Response to Answer,
Page 21, Second and Third Full Paragraphs

The Brief addresses these paragraphs.

Response to Answer,
Last Paragraph on Page 21

The Brief addresses this paragraph. Further, even if this paragraph of the Answer is correct, it does not rebut the Brief.

Further still, Nehab's history of a user's navigation does not indicate that Nehab contacts "another web site" as claimed.

Response to Answer,
Page 22, First Full Paragraph

The claims state that the actions recited are done in "a method of operating a web site."

Thus, the actions shown in the reference must be done in "a method of operating a web site."

Response to Answer,
Page 22, Second Full Paragraph

Point 1

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Appellant's Brief, page 58, states:

> In rejecting parent claim 1, the PTO asserted that the "first background research" was found when a web site looked up a name stored in a cookie.
>
> Now, in rejecting claim 3, the PTO asserts that Nehab's list of web sites forms the "background research."
>
> If so, then how is the name of the visitor, supposedly obtained from the cookie in Javascript and used to show the "background research" of claim 1, now obtained from the list of web sites ?
>
> That is, how does the name of the user get included into the list of web sites, so that the name can be obtained ?

The Answer has not answered the question in the third paragraph, above.

-- For claim 1, the PTO obtained the "name"

from a cookie.

-- For claim 3, the PTO obtains the same

"name" from a list of web sites.

How is that possible ?

Point 2

The Answer gives a reason why the "name" should be included in the material which is presented to Nehab's user: a personalized experience is obtained.

However, that inclusion does not show the claim.

Further, the reason is suspect. The user already knows his name. What is the point of repeating it ?

Response to Answer,
Last Paragraph on Page 22

The claim states that a second background research is done on a second visitor, and the same web site is contacted as for the first background research.

The Answer merely asserts that a second visit is made to a web site in Nehab. But that second visit, even if present, relates to the **single user** in Nehab. No second visitor, as claimed, has been shown.

Response to Answer,
Page 23, First Full Paragraph

The Brief, page 63 et seq., addresses this paragraph.

Comment on "Personalized Experience"

The Answer, in three paragraphs on pages 22 and 23, justifies modifying the references by including a name in certain places, on the grounds that a "personal experience" is obtained.

However, that merely sets forth a supposed characteristic of the modification, but stated in different words. That is not a justification for making the modification, nor is it a teaching

under section 103.

By analogy, one could say that painting one's car red is desirable, because red is the longest wavelength visible color. But that is not actually a reason. That merely sets forth a characteristic of the color red. If you paint the car red, you necessarily get the characteristic.

That is the same as saying "it is desirable to paint it red, because red is desirable."

The same principle applies to the PTO's addition of the name. The fact that adding the name makes something "personal" is not a justification for adding the name. It is just another way of saying that a name is added.

Further, an opposing argument is equally valid. **Eliminating** the name can be said to be desirable because it makes the situation less personal, and more objective.
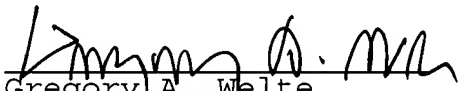
Isn't objectivity always desirable ?

CONCLUSION

Appellant requests that the Board overturn all rejections, and pass all claims to issue.

Respectfully submitted,

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